



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0975-00

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Daniela GIACCHETTI et al.) Group Art Unit: 3629
)
Application No.: 10/024,622) Examiner: Borissov, Igor N.
)
Filed: December 21, 2001)
)
For: HISTORICAL BEAUTY RECORD) Confirmation No.: 3918

Mail Stop Appeal Brief--Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on April 1, 2005.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

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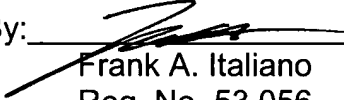
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PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,
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Dated: October 3, 2005

By: 
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PATENT
Customer No. 22,852
Attorney Docket No. 05725.0975-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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For: HISTORICAL BEAUTY RECORD) Confirmation No.: 3918

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed April 1, 2005, and pursuant to 37 C.F.R. § 41.37, Appellants submit this Appeal Brief and enclose herewith a check for the fee of \$500.00 required under 37 C.F.R. § 41.20(b)(2). The period for filing this brief has been extended to October 3, 2005, (October 1, 2005, being a Saturday) by the accompanying Petition of Extension of Time of four (4) months and appropriate fee payment. If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

This appeal responds to the final Office Action mailed December 1, 2004, ("Final Office Action") finally rejecting claims 1-25 and 27-61, which are set forth in attached Appendix A.

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I. Real Party In Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office, beginning at Real 012939, Frame 0415, on May 30, 2002.

II. Related Appeals and Interferences

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of Claims

Claims 1-25 and 27-61, as set forth in Appendix A, have been finally rejected in the Final Office Action. The Final Office Action objected to claim 26, as set forth in Appendix A, as being in improper form but did not address the claim on the merits. The rejections applied to claims 1-25 and 27-61 are at issue in this appeal.

IV. Status Of Amendments

Appellants file, concurrently with this Brief, an Amendment under 37 C.F.R. § 41.33(b)(2) proposing to cancel claim 26. No further amendments have been filed subsequent or in response to the Final Office Action.

V. Summary Of Claimed Subject Matter

Consistent with the invention, as set forth in independent claim 1, a beauty care method is provided. The method involves obtaining first information representative of an external body condition of a subject (Fig. 2A: 200) and obtaining second information representative of the external body condition of the subject (Fig. 2A: 201) after the subject uses a beauty product. *See, e.g.,* Appellants' specification: pages 7-8, ¶¶ 026-029.¹ The method further involves facilitating storage of information reflecting the subject's usage of the beauty product (Fig. 2A: 202) and enabling the subject to view the first information, the second information, and at least part of the stored information (Fig. 2A: 203). *See, e.g.,* specification: pages 8-9, ¶¶ 30-33; page 11, ¶ 038. *See also* specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in dependent claim 53, a beauty care method as defined by claim 1 is provided that further comprises presenting to the subject at least one depiction of data quantifying an effectiveness of the beauty product based on the first information, the second information, and at least part of the stored information. *See, e.g.,* specification: pages 15-16, ¶¶ 051-052.

Consistent with the invention, as set forth in independent claim 5, a beauty care method is provided. The method involves providing information about beauty products. *See, e.g.,* specification: page 8, ¶ 29; page 9, ¶ 034. The method also involves facilitating electronic capture of a first image of an external body condition of a subject (Fig. 2B: 210) and encouraging the subject to use at least one of the beauty products.

¹ In referring to the specification and drawings, Appellants do not intend to limit the scope of the claims to the exemplary embodiments described in the specification and shown in the drawings. Rather, Appellants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

See, e.g., specification: page 7, ¶ 026; pages 10-13, ¶¶ 036-047; pages 14-15, ¶048-049; Fig. 4, 6-8 and accompanying text. The method further involves facilitating, after the subject has used the at least one beauty product, electronic capture of a second image of the external body condition of the subject (Fig. 2B: 215), wherein capture of at least one of the first and second images occurs at a beauty facility (e.g., Fig. 6: 604).

See, e.g., specification: page 10, ¶ 35; page 15, ¶ 050. The method includes facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image. See, e.g., specification: page 9, ¶ 032; page 11, ¶ 038; pages 15-18, ¶¶ 051-055. The method additionally includes enabling the subject to view the first image, the second image, and the stored information on a display device (e.g., 705), to thereby visually observe changes that occurred between times when the first and second images were captured. See, e.g., specification: pages 15-18, ¶¶ 051-055; Fig. 1 and accompanying text; Fig. 2B: 220. See also specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in dependent claim 25, a beauty care method as defined by claim 5 is provided in which the recordable media includes a visible marking identifying at least the distributor (e.g., Fig. 6: 600). See, e.g., specification: pages 11-12, ¶¶ 040-042; Fig. 3; 301, 302, 303 and accompanying text.

Consistent with the invention, as set forth in dependent claim 28, a beauty care method as defined by claim 5 is provided that further comprises enabling the beauty facility to store the first image on recordable media (e.g., Fig. 3: 301, 302, 303), and encouraging the beauty facility to recommend to the subject that the subject capture

and store the second image on the recordable media at a location remote from the beauty facility. See, e.g., specification: pages 11-12, ¶¶ 040-045.

Consistent with the invention, as set forth in dependent claim 54, a beauty care method defined by claim 5 is provided that further comprises processing the first and second images of the external body condition of the subject to accentuate differences between the images. See, e.g., specification: pages 16-18, ¶ 053-055; Figs. 1, 5 and accompanying text.

Consistent with the invention, as set forth in dependent claim 55, a beauty care method as defined by claim 5 is provided that further comprises processing the first and second images of the external body condition of the subject to detect differences between said images and providing advice to a subject based on the detected differences and based on personal information associated with the subject. See, e.g., Appellants' specification: pages 16-18, ¶¶ 053-055; Figs. 1, 5 and accompanying text.

Consistent with the invention, as set forth in dependent claim 56, a beauty care method as defined by claim 5 is provided that further comprises determining a probable cause of a difference between the first and second images of the external body condition using personal information associated with the subject and presenting to the subject the determined probable cause along with preventative measures. See, e.g., Appellants' specification: page 18, ¶ 055; Fig. 5.

Consistent with the invention, as set forth in independent claim 31, a method of recording beauty information is provided. The method involves capturing, through a beauty facility (e.g., Fig. 6: 604), at least a first image of an external condition of a subject and establishing a subject record that includes the first image. See, e.g.,

specification: page 7, ¶ 026; pages 10-13, ¶ 035-047. The method also involves prescribing a cosmetic product to the subject for treating the external condition. See, e.g., specification: page 8, ¶ 29; page 14, ¶ 048. Additionally, the method involves capturing, through the beauty facility, at least a second image of the external condition of the subject, the second image being captured after the first image is captured. See, e.g., specification: page 15, ¶ 050. The method further involves associating the at least one second image with the subject record and providing the subject with viewing access to the subject record. See, e.g., specification: pages 15-17, ¶¶ 051-054. See also specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 32, a method of selling cosmetic products is provided. The method involves providing a beauty facility (e.g., Fig. 6: 604) with technology for capturing external body condition images of a customer and distributing at least one cosmetic product to the beauty facility. See, e.g., specification: page 7, ¶ 026; page 8, ¶ 29; pages 9-10, ¶¶ 034-036; Fig. 2B: 205, 210; Figs. 7, 8, and accompanying text. The method also involves instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product. See, e.g., specification: pages 15, ¶ 050. Further, the method involves instructing the beauty facility to display to the customer the before and after images so that the customer may be provided with a visual indication of progress. See, e.g., specification: pages 15-18, ¶ 051-055; Figs. 1, 5. See also specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in dependent claim 57, a method of selling cosmetic products as defined by claim 32 is provided in which instructing the

beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product includes instructing the beauty facility to capture and store information reflecting a nature of the application of the at least one cosmetic product. *See, e.g.,* specification: page 9, ¶ 032; page 11, ¶ 038.

Consistent with the invention, as set forth in independent claim 39, a beauty analysis method is provided. The method involves enabling a subject to record personal beauty information (*see, e.g.,* specification: page 11, ¶ 038) on a transportable medium (*e.g.,* Fig. 3: 301, 302, 303). *See, e.g.,* specification: pages 11-13, ¶¶ 040-045. The method also involves enabling a plurality of beauty facilities (*e.g.,* Fig. 6: 604) to read the information on the transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities. *See, e.g.,* specification: page 10, ¶ 035; pages 11-13, ¶¶ 041-042, ¶ 044; page 19; ¶ 057. In addition, the method involves enabling the personal information to be updated by the subject at a location (*e.g.,* Fig. 6: 607) remote from a beauty facility. *See, e.g.,* specification: pages 11-13, ¶¶ 041-042, ¶ 044. *See also* specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 44, a beauty analysis method is provided. The method involves enabling a beauty facility (*e.g.,* Fig. 6: 604) to record on transportable medium (Fig. 3: 301, 302, 303) personal beauty information about a subject and enabling the subject to access, at a location (*e.g.,* Fig. 6: 607) remote from the beauty facility, the personal beauty information. *See, e.g.,* specification: page 10, ¶ 35; pages 11-13, ¶¶ 040-045; Fig. 6 and accompanying text. The method further involves enabling the subject to update, at a location (*e.g.,* 607) remote from the beauty facility, the personal beauty information and enabling the

subject to compare, at a location remote from the beauty facility, the accessed personal beauty information and the updated personal beauty information. See, e.g., specification: page 12-13, ¶¶ 041-045. See also specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 45, a beauty tracking method is provided. The method involves enabling an individual to record in a data structure information about the individual's cosmetic product usage. See, e.g., specification: page 8, ¶ 29; page 9, ¶ 032; page 11, ¶ 038; pages 11-12, ¶ 040; pages 19-25, ¶¶ 56-74; Figs. 6-9. The method further involves enabling the individual to record in the data structure personal information, other than the cosmetic product usage information. See, e.g., specification: page 11, ¶ 038. The personal information includes at least one of lifestyle information, information about physical characteristics of the individual, fashion preferences, area of residence, vacation patterns, and climate and weather conditions at areas of vacation and residence. See, e.g., specification: page 11, ¶ 038. The method also involves enabling an individual to update in the data structure cosmetic product usage information and personal information. See, e.g., specification: pages 11-12, ¶¶ 039-040. Additionally, the method involves enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information and causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record. See, e.g., specification: pages 13-14, ¶¶ 047-048; page 18, ¶ 055. See also specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 46, a beauty advisory method is provided. The method involves enabling a subject to record in a data structure information about the subject's cosmetic product usage and about the subject's lifestyle. *See, e.g.,* specification: page 8, ¶ 29; page 9, ¶ 032; pages 11-13, ¶¶ 038-047; Figs. 6, 7 and accompanying text. The method further involves comparing the recorded information with a database (e.g., Fig. 8: 805) of information on cosmetic usage and lifestyles of a plurality of individuals and determining whether the subject's cosmetic usage is consistent with the cosmetic usage and lifestyles of a trend of use by at least some of the plurality of individuals. *See, e.g.,* specification: pages 14-15, ¶ 049; Fig. 8 and accompanying text (e.g., pages 21-22, ¶¶ 064-065). In addition, the method involves causing, when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject. *See, e.g.,* specification: pages 14-15, ¶ 049; Fig. 8 and accompanying text (e.g., pages 21-22, ¶¶ 064-065). *See also* specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 48, a beauty tracking method is provided. The method involves offering for sale beauty products. *See, e.g.,* specification: page 8, ¶ 29; page 9, ¶ 034. The method further involves facilitating electronic capture of a first image of an external body condition of a subject. *See, e.g.,* specification: page 7, ¶ 026; pages 10-11, ¶¶ 036-037; Fig. 2B: 210. The method involves encouraging the subject to use at least one of the beauty products and facilitating, after the subject has used the at least one cosmetic product, electronic capture of a second image of the external body condition of the subject, wherein

capture of at least one of the first and second images occurs at a beauty facility. *See*, e.g., specification: page 14, ¶ 048; page 15, ¶ 050; Fig. 2B: 215. The method also involves facilitating capture and storage of information reflecting usage of at least one of the cosmetic products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image. *See*, e.g., specification: pages 8-9, ¶ 30-32; page 11, ¶ 038. The method additionally involves enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured. *See*, e.g., specification: pages 15-18, ¶ 051-055; Figs. 1, 5. *See also* specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 49, a method for encouraging use of a beauty product is provided. The method involves providing information about beauty products. *See*, e.g., specification: page 8, ¶ 29; page 9, ¶ 034. The method also involves providing instructions for storage of first information relating to an external body condition of a subject in a first time frame and providing instructions for storage of second information relating to an external body condition of a subject in a second time frame. *See*, e.g., specification: pages 7-8, ¶¶ 026-029. In addition, the method involves analyzing the first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames and prescribing at least one beauty product based on the extent of determined differences. *See*, e.g., specification: pages 16-18, ¶¶ 053-055; Figs. 1, 5 and accompanying text. *See also* specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

Consistent with the invention, as set forth in independent claim 50, a method of recording beauty information is provided. The method involves providing information about beauty care. See, e.g., specification: page 8, ¶ 29; page 9, ¶ 034. The method also involves providing instructions for storage of first information relating to an external body condition of a subject in a first time frame, providing instructions for storage of second information relating to an external body condition of a subject in a second time frame, and providing instructions for storage of third information relating to behavior of a subject between the first and second time frames. See, e.g., specification: pages 7-8, ¶¶ 026-030; page 11, ¶ 038; Fig. 2A: 200, 201, 202. The method further involves establishing a subject record, the record including the first, second and third information, wherein the subject is enabled to maintain control of the subject record. See, e.g., specification: pages 11-14, ¶¶ 040-048. See also specification: pages 19-25, ¶¶ 56-74; Figs. 6-9.

VI. Grounds of Rejection

The following grounds of rejection are to be reviewed:

A. Claims 1-4, 32-47, 49-53, and 57-61 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter;

B. Claims 1-24, 27, 29, 30, 32-38, 45, 48, 50, and 54 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2002/0054714 ("*Hawkins*");

C. Claim 45 stands rejected under 35 U.S.C. § 102(e) as anticipated by PCT International Publication No. WO 01/18674 A2 ("*Maloney*");

D. Claim 28 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins*;

E. Claim 25 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins* in view of AS/400 Redbook Softcopy Library image ("AS/400");

F. Claims 39-44, 58, and 59 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Maloney*;

G. Claims 46 and 47 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0077219 ("*Cohen*") in view of *Maloney*; and

H. Claims 31, 49, 51-53, and 55-57² stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins* in view of *Maloney*.

² Claims 60 and 61 are mentioned in the Final Office Action at page 19 in the Examiner's explanation of the Section 103 rejection based on *Hawkins* and *Maloney*, but those claims are not listed in the rejection statement appearing in the Final Office Action at page 16.

VII. Argument

Each claim of the present application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282. The arguments set forth below are arranged under subheadings, and in accordance with 37 C.F.R. § 41.37(c)(1)(vii), these subheadings indicate the claims whose patentabilities are argued separately.

A. The rejection of claims 1-4, 32-47, 49-53, and 57-61 under 35 U.S.C. § 101 should be reversed because these claims define statutory subject matter

According to the Final Office Action, claims 1-4, 32-47, 49-53, and 57-61 are not within the “technological arts” and are directed to “purely an abstract idea.” Final Office Action at 2-8. The § 101 rejection should be reversed because, contrary to the Examiner’s position, Appellants’ claims are indeed directed to statutory subject matter.

1. The Examiner’s “technological arts” analysis is not supported and fails to establish that claims 1-4, 32-47, 49-53, and 57-61 are non-statutory

The Examiner’s so-called “technological arts” analysis is not supported by proper authority and fails to establish that claims 1-4, 32-47, 49-53, and 57-61 are directed to non-statutory subject matter.

The Final Office Action alleges that the claims “are completely silent with regard to technology and [are directed to] . . . purely an abstract idea or process steps that are employed without the use of any technology.” Final Office Action at 7-8. According to the Examiner, the claims “are no more than a suggested idea of allowing a customer to see how she/he looks after the customer used a beauty product.” *Id.* at 8. The Examiner alleged that the claims recite abstract ideas that “can be performed without

interaction of a physical structure.” *Id.* at 8. The Examiner also alleged that there are “absolutely no limitations in [the claims] . . . that would suggest a computer or data processing device is being used to carry out the processes.” *Id.* at 8.

In an attempt to support the technological arts analysis, the Examiner cited *In re Toma*, 575 F.2d 872, 197 USPQ 852 (CCPA 1978). Final Office Action at 3. According to the Examiner, the court in *Toma* developed a “technological arts” analysis and found the claimed process at issue within the “technological art” because it was “an operation being performed by a computer within a computer.” *Id.* at 3-4. *In re Toma*, however, does not provide a basis for the Examiner’s “technological arts” analysis. Although the court in *Toma* recognized a “technological” or “useful” arts inquiry and found the claimed method at issue to be in the technological arts, the court rejected the “technological arts” rejection set forth by the Examiner in that case, explaining that the language in *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (1970), *In re Benson*, 441 F.2d 682, 169 USPQ 548 (1971), *Gottschalk v. Benson*, 409 US 63, 175 USPQ 673 (1972), and *In re McIlroy*, 442 F.2d 1397, 170 USPQ 31 (1971) regarding “mental steps” rejections “was not intended to create a generalized definition of statutory subject matter . . . [and] was not intended to form a basis for a new § 101 rejection.” *In re Toma*, 575 F.2d at 877-78, 197 USPQ at 857. Appellants submit that the Final Office Action does not provide from *Toma* a basis for the “technological arts” rejection of claims 1-4, 32-47, 49-53, and 57-61.

The Examiner also cited *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970) to support the § 101 rejection. Final Office Action at 3. The Examiner alleged that “the first test of whether an invention is eligible for a patent is to determine if the

invention is within the 'technological arts.'" *Id.* *In re Musgrave*, however, states that the presumption that the law "requires all steps of a statutory 'process' to be physical acts applied to physical things" is an "erroneous idea." *In re Musgrave*, 431 F.2d at 892-93, 167 USPQ at 289. The court noted that "it was a misconstruction to assume that 'all processes, to be patentable, must operate physically upon substances.'" 431 F.2d at 893, 167 USPQ at 289. Additionally, the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations "reflects a misunderstanding of...[the] case law." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999) (emphasis added), 50 USPQ2d 1447, 1452-1453. Indeed, in *AT&T*, the claims at issue involved information exchange alone.

Even if, as the Examiner alleged, "the first test of whether an invention is eligible for a patent is to determine if the invention is within the 'technological arts'" (to which Appellants do not acquiesce), the position that process claims are abstract and not within the technological arts because they "can be performed without interaction of a physical structure" is not supported by the relevant case law. The position that Appellants claims are abstract and not within the technological arts because they allegedly lack features indicating that "a computer or data processing device is being used to carry out the processes" is equally unsupported. For at least these reasons, the Examiner's "technological arts" rejection of claims 1-4, 32-47, 49-53, and 57-61 set forth in the Final Office Action is improper and should be reversed.

The Examiner alleged that the decision in *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d-1368, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998)

“never addressed the . . . “technological arts” test established in *Toma* because the invention in *State Street* . . . was already determined to be within the technological arts under the *Toma* test.” Final Office Action at 4. The Examiner averred that the Board recognized this dichotomy in *Ex parte Bowman*, 61 USPQ2d 1669 (2001). *Id.*

As explained above, *In re Toma* makes clear that the language in the case law regarding mental steps and technological arts “was not intended to form a basis for a new § 101 rejection” *In re Toma*, 575 F.2d at 877-78, 197 USPQ at 857. Moreover, the decision in *Ex parte Bowman* does not support the notion that determining the presence of an abstract idea, which was addressed in *State Street*, is a separate and distinct inquiry from determining whether a claimed invention is in the “technological arts.” In *Ex parte Bowman*, the Board interpreted the Examiner’s § 101 rejection in that case as “finding that the claimed invention . . . is nothing more than an abstract idea because it is not tied to any technological art or environment.” *Ex parte Bowman*, 61 USPQ2d at 1671 (emphasis added). The Board in *Ex parte Bowman* did not recognize the “technological arts” analysis as a distinct test, separate from the abstract idea inquiry, for determining whether a claim is directed to statutory subject matter. *See id.* Instead, the Board merely found that the claimed invention at issue was an abstract idea because it lacked connection to a technological art. In this case, Appellants submit that claims 1-4, 32-47, 49-53, and 57-61 are *not* abstract because, as explained in the following section of this brief, the claims include recitations that produce “concrete, tangible and useful” results. *See State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-01; *AT&T Corp.*, 172 F.3d at 1358, 50 USPQ2d at 1451-52.

Furthermore, claims 1-4, 32-47, 49-53, and 57-61 are tied to a technological art. In *Ex parte Bowman*, the Board's decision to affirm the § 101 rejection was based in part on the fact that neither the claims nor the specification discussed "the use of any technology with respect to the claimed invention." *Ex parte Bowman*, 61 USPQ2d at 1671. The Board found that the invention was "not tied to any technological art . . . and [was] not a useful art" *Id.* In this case, as further detailed below, the claim language itself ties the claimed invention to the technological arts. Additionally, the specification in this application discusses several technological applications related to the claimed invention, thereby tying those claims to a technological art. See Appellants' specification at, for example, page 10, ¶ 036; pages 11-14, ¶¶ 039-048; pages 19-25, ¶¶ 56-74; Figs. 1, 3, 4, 5-9. The invention defined in claims 1-4, 32-47, 49-53, and 57-61 is therefore clearly tied to a technological art, and *Ex parte Bowman* does not support the Examiner's § 101 rejection.

The Examiner's allegations that the claims "are employed . . . without the use of any technology" and "can be performed without interaction of a physical structure" are not supported by evidence and fail to establish that the claims are not tied to a technological art. For example, the Final Office Action does not articulate what subject matter would constitute "the use of . . . technology," and the case law cited by the Examiner makes clear that physical structures and computer-related limitations are not required for a claim to be statutory. Accordingly, the Examiner's allegation that the claims lack "the use of any technology whatsoever" is not properly supported and does not establish that Appellants' claims are non-statutory. Indeed, Appellants submit that,

by virtue of at least the following features, Appellants claims are not “completely silent with regard to technology:”

“facilitating storage of information reflecting the subject’s usage of the beauty product” (see claim 1);

“providing a beauty facility with technology for capturing external body condition images of a customer” (see claim 32);

“enabling a plurality of beauty facilities to read the information on [a] . . . transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities” (see claim 39);

“enabling a beauty facility to record on transportable medium personal beauty information about a subject” (see claim 44);

“enabling an individual to record in a data structure information about the individual’s cosmetic product usage” (see claim 45);

“enabling a subject to record in a data structure information about the subject’s cosmetic product usage and about the subject’s lifestyle; [and] comparing the recorded information with a database of information on cosmetic usage and lifestyles of a plurality of individuals” (see claim 46);

“providing instructions for storage of first information relating to an external body condition of a subject in a first time frame” (see claims 49 and 50).

In the § 101 rejection, the Examiner also noted M.P.E.P. § 2106(IV)(B)(2)(b), which states, in part:

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan . . . or (B) be limited to a practical application within the technological arts See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877))

The Examiner alleged that the claims “do not recite any physical transformation of data whatsoever.” Final Office Action at 8. The Examiner also alleged that there is no physical transformation of data “based upon an algorithm or a calculation by a computer or processor” and no “technology claimed that would be used to transform the data.” *Id.* These allegations by the Examiner do not establish that the claims are non-abstract and not tied to a technological art.

As indicated above, M.P.E.P. § 2106(IV)(B)(2)(b) states that a claimed process is statutory if it is “limited to a practical application within the technological arts.” M.P.E.P. § 2106(IV)(B)(2)(b) clearly states that: “[a] claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful . . .” (internal citations omitted). Regardless of whether claims 1-4, 32-47, 49-53, and 57-61 recite a process that results in a physical transformation outside a computer, the claims are limited to a practical application within the technological arts, since, as explained in the following section of this Brief, the claims produce concrete, tangible and useful results.

Furthermore, M.P.E.P. § 2106(II)(A) states:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101...Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection (internal citations omitted).

In this case, the Examiner failed to establish the *prima facie* showing required by M.P.E.P. § 2106. The conclusory statements in the Final Office Action are unsupported by evidence and do not establish that the claims are in fact “devoid of any limitation to a practical application in the technological arts.”

M.P.E.P. § 2106(II)(A) makes clear that “Office personnel should review the entire disclosure to determine the features necessary to accomplish at least one asserted practical application.” M.P.E.P. § 2106(II)(C) further states that:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation.

Thus, within the context of 35 U.S.C. § 101, the Examiner must consider the accompanying disclosure when construing a claim’s practical application. Further, when responding to an allegation that a claim lacks practical application, Applicants are entitled to point out portions of the specification to show that claim’s practical application and the Examiner should consider such portions of the specification. In this case, as noted above, Appellants’ specification discusses several technological applications related to the features defined in claims 1-4, 32-47, 49-53, and 57-61, thereby showing “a practical application in the technological arts” with respect to those claims.

For at least the foregoing reasons, the Examiner’s “technological arts” rejection of claims 1-4, 32-47, 49-53, and 57-61 is improper and should be reversed. As explained above, claims 1-4, 32-47, 49-53, and 57-61 are non-abstract and are tied to the useful or “technological” arts, regardless of whether they specifically recite “physical structure” or computer-related limitations. The Examiner’s “technological arts” analysis

is not supported by proper authority and fails establish that claims 1-4, 32-47, 49-53, and 57-61 are non-statutory.

2. Claims 1-4, 32-47, 49-53, and 57-61 are not abstract and are therefore statutory

The Final Office Action alleges that “[t]he claims are no more than a suggested idea of allowing a customer to see how she/he looks after the customer used a beauty product.” Final Office Action at 8. The Final Office Action further alleges that “*obtaining information and facilitating storage of information* does not provide a useful, concrete and tangible result.” *Id.*

Contrary to the Examiner’s position, claims 1-4, 32-47, 49-53, and 57-61 are not abstract. According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-01; *AT&T Corp.*, 172 F.3d at 1358, 50 USPQ2d at 1451-52. And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

The Examiner’s conclusory statement that the claims are directed to “purely an abstract idea” is unsupported and does not establish that the claims are in fact directed to an abstract idea. Claims 1-4, 32-47, 49-53, and 57-61 do in fact include recitations that produce “concrete, tangible and useful” results and, therefore, accomplish a practical application and are not abstract.

For example, claim 1 recites, *inter alia*, “facilitating storage of information reflecting the subject’s usage of the beauty product.” The Examiner’s allegation that this feature does not provide a useful, concrete and tangible result is conclusory and not supported by evidence. The Federal Circuit articulated in *State Street* that “the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation.” *See State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601. In *AT&T Corp.*, the Federal Circuit explained that the same principles apply to method claims that do not recite a machine, stating “we consider the scope of Section 101 to be the same regardless of the form--machine or process--in which a particular claims is drafted.” *AT&T Corp.* 172 F.3d at 1357 (citations omitted), 50 USPQ2d at 1450-52. In *AT&T Corp.*, the court held that information representative of a call recipient’s PIC, is “a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC’s subscriber.” *Id.* at 1358; 50 USPQ2d at 1451-52. The recitation in claim 1 of “facilitating storage of information reflecting the subject’s usage of the beauty product,” like the information representative of a call recipient’s PIC addressed in *AT&T Corp.*, is a useful, non-abstract result. That useful result facilitates, for example, viewing of the information by the subject so that the subject can appreciate the effectiveness of a beauty product. Also, “facilitating storage of information” could indeed involve interaction of a physical structure.

Like claim 1, each of independent claims 32, 39, 44, 45, 46, 49, and 50 includes recitations that produce “a concrete, tangible and useful result” and could indeed involve

interaction of a physical structure. For example, at least by virtue of the following features, claims 32, 39, 44, 45, 46, 49, and 50 are non-abstract:

“providing a beauty facility with technology for capturing external body condition images of a customer” (see claim 32);

“enabling a plurality of beauty facilities to read information on [a] . . . transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities” (see claim 39);

“enabling a beauty facility to record on transportable medium personal beauty information about a subject” (see claim 44);

“enabling an individual to record in a data structure information about the individual’s cosmetic product usage” (see claim 45);

“enabling a subject to record in a data structure information about the subject’s cosmetic product usage and about the subject’s lifestyle; [and] comparing the recorded information with a database of information on cosmetic usage and lifestyles of a plurality of individuals” (see claim 46);

“providing instructions for storage of first information relating to an external body condition of a subject in a first time frame” (see claims 49 and 50).

Claims 1, 32, 39, 44, 45, 46, 49, and 50 are drawn to useful, concrete, and tangible results, and are therefore not abstract but, rather, statutory under 35 U.S.C. § 101. Likewise, claims 2-4, 33-38, 40-43, 47, 51-53, and 57-61, each of which depends upon one of claims 1, 32, 39, 44, 46, 49, and 50, are drawn to useful, concrete, and tangible results and are therefore statutory.

Furthermore, as explained above, Appellants’ claims are tied to the useful or “technological” arts, regardless of whether they specifically recite “physical structure” or computer-related limitations. Thus, even if the § 101 rejection in the Final Office Action

is interpreted as finding that claims 1-4, 32-47, 49-53, and 57-61 are abstract because they are not tied to a technological art, the rejection should be reversed.

For at least the foregoing reasons, Appellants request reversal of the rejection of claims 1-4, 32-47, 49-53, and 57-61 under 35 U.S.C. § 101.

B. The rejection of claims 1-24, 27, 29, 30, 32-38, 45, 48, 50, and 54 under 35 U.S.C. § 102(e) based on *Hawkins* should be reversed because *Hawkins* does not anticipate those claims

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P § 2131; *see In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, the rejection of claims 1-24, 27, 29, 30, 32-38, 45, 48, 50, and 54 under 35 U.S.C. § 102(a) should be reversed because the Final Office Action fails to establish that *Maloney* teaches each and every element of Appellant's claimed invention, as discussed in detail below.

1. Claims 1-4

The Final Office Action fails to establish that *Hawkins* teaches each and every feature of claims 1-4. In particular, the Final Office Action fails to establish that *Hawkins*

teaches “facilitating storage of information reflecting the subject’s usage of the beauty product,” as recited in claim 1 and required by dependent claims 2-4.

Hawkins describes a system for demonstrating the effects of cosmetic products over a period of time (Abstract). In rejecting Appellants’ claims, the Examiner noted *Hawkins*’s disclosure of capturing images of a “body feature” and that an image of a consumer can be “digitally transformed . . . to demonstrate effects of a cosmetic product treatment.” Final Office Action at 9-10 (*citing Hawkins*, ¶ 0039, ¶ 0041, ¶ 0044). This functionality disclosed in *Hawkins* does not anticipate the “facilitating storage” feature of claim 1. *Hawkins* discloses capturing images before and after application of a product (¶¶ 0039, 0041). According to *Hawkins*, the image of the body feature captured before application of the product can be digitally transformed “in accordance with a predicted effect” of a cosmetic product treatment (¶ 0043, *see* claims 1, 5-7). *Hawkins* discloses that the digitally transformed image can be compared with the “later time captured image representing an actual cosmetic product treated body feature” (¶ 0043). *Hawkins*’s digitally transformed image, even if stored, does not reflect the subject’s usage of a beauty product (e.g., frequency and intensity of usage). Instead, it reflects a predicted effect of a product. An image reflecting a predicted effect, as disclosed by *Hawkins*, does not constitute information reflecting a subject’s usage of a beauty product.

The Examiner also noted *Hawkins*’s disclosure of capturing images of a body before and after application of a product and allowing a comparison between images. Final Office Action at 20 (*citing Hawkins*, ¶ 0039-0042). The Examiner appears to equate *Hawkins*’s image captured after the application of a product with the claimed

“second information” and also the claimed “information reflecting the subject’s usage of the beauty product.” Contrary to the Examiner’s position, an image captured after application of a product does not constitute “information reflecting the subject’s usage of the beauty product.” Although *Hawkins*’s after image may reflect an improvement or a worsening of a body condition as a result of a product, the image does not constitute information reflecting a subject’s usage of a beauty product, such as frequency and intensity of usage. Indeed, neither the relied-upon disclosures nor any other disclosures from *Hawkins* teaches the “facilitating storage” feature of claim 1. For at least these reasons, the Examiner has not established that *Hawkins* teaches the invention defined by claim 1.

Furthermore, even if all of the elements of independent claim 1 could be found in various teachings of *Hawkins* – Appellants disputing that contention – the reference does not clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention “without any need for picking, choosing, and combining various disclosures.” *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (emphasis added).

Because *Hawkins* does not teach each and every element of claim 1, as a matter of law, it cannot anticipate that claim. As such, the rejection of claim 1 under 35 U.S.C. §102(a) based on *Hawkins* should be reversed. The § 102(a) rejection of claims 2-4 should be reversed as well, at least because those dependent claims include all of the features of claim 1 and are likewise distinguishable from the cited art.

2. Claims 5-24, 27, 29, 30, and 48

The Final Office Action fails to establish that *Hawkins* teaches each and every feature of claims 5-24, 27, 29, 30, and 48. Similar to claim 1, independent claim 5 recites a combination including:

facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

Independent claim 48 recites, *inter alia*:

facilitating capture and storage of information reflecting usage of at least one of the cosmetic products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

While claims 5 and 48 are of different scope than claim 1 (and from each other), *Hawkins* does not teach the “facilitating capture and storage” features of claims 5 and 48 for at least reasons similar to those presented above in connection with claim 1. Because *Hawkins* does not teach each and every element of claims 5 and 48, as a matter of law, it cannot anticipate those claims. The rejection of claims 5 and 48 under 35 U.S.C. §102(a) based on *Hawkins* should thus be reversed. Also, the § 102(a) rejection of claims 6-24, 27, 29, and 30 should be reversed, at least because those dependent claims include all of the features of claim 5 and are likewise distinguishable from the cited art.

3. Claim 45

The Final Office Action fails to establish that *Hawkins* teaches or suggests each and every feature of claim 45. Claim 45 recites, *inter alia*:

enabling the individual to record in the data structure personal information, other than the cosmetic product usage information, the personal information including at least one of lifestyle information, information about physical characteristics of the individual, fashion preferences, area of residence, vacation patterns, and climate and weather conditions at areas of vacation and residence;

enabling an individual to update in the data structure cosmetic product usage information and personal information; [and]

enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information.

Hawkins does not teach the above-noted features and therefore cannot anticipate claim 45. In fact, the Final Office Action does not address the above-noted features of claim 45 in the rejection based on *Hawkins*. Because the Examiner failed to establish that *Hawkins* teaches each and every feature of claim 45, the Examiner has not established that *Hawkins* anticipates claim 45. For at least this reason, the rejection of claim 45 under 35 U.S.C. §102(a) based on *Hawkins* should be reversed.

4. Claim 50

The Final Office Action fails to establish that *Hawkins* teaches each and every feature of claim 50. In particular, *Hawkins* does not teach at least “providing instructions for storage of third information relating to behavior of a subject between the first and second time frames,” as claimed.

Although *Hawkins* mentions “capturing” images before and after usage of a product (¶¶ 0039, 0041) and transforming images “in accordance with a predicted effect” to demonstrate effects of a cosmetic product treatment” (¶¶ 0043-0044), the reference does not teach “storage of . . . information relating to behavior of a subject

between . . . first and second time frames,” as recited in claim 50. An image reflecting a predicted effect does not constitute information relating to behavior of a subject between first and second time frames. In addition, capturing an image after application of a product does not constitute storage of information relating to behavior of a subject. An image captured after a product application does not constitute stored information relating to behavior of the subject (e.g., the manner in which the subject applied the product), at best, the image would merely display results of that product application. That is, while *Hawkins* image might reflect the results of a product application, it does not include information relating to the behavior of the subject in applying the product. For at least these reasons, *Hawkins* does not teach the “storage of . . . information relating to behavior” subject matter recited in claim 50.

Because *Hawkins* does not teach each and every element of claim 50, as a matter of law, it cannot anticipate that claim. As such, the rejection of claim 50 under 35 U.S.C. §102(a) based on *Hawkins* should be reversed.

5. Claim 54

The Final Office Action fails to establish that *Hawkins* teaches each and every feature of claim 54. Claim 54 depends upon claim 5 and therefore includes all of the features recited in claim 5, including the “facilitating capture and storage of information” feature noted above. For at least the reasons presented above in connection with claim 5, claim 54 is distinguishable from *Hawkins*.

In addition, the Final Office Action does not establish that *Hawkins* teaches “processing the first and second images of the external body condition of the subject to accentuate differences between the images,” as recited in claim 54. The Examiner

alleged that *Hawkins* discloses “displaying . . . side by side an original image and a digitally transformed image of the subject’s face to demonstrate effects . . . of a cosmetic product treatment . . .” Final Office Action at 12. Appellants disagree with the Examiner’s interpretation of *Hawkins*. *Hawkins* discloses transforming an image of a body feature captured before application of a product “in accordance with a predicted effect” to demonstrate effects of a cosmetic product treatment” (§§ 0043-0044). This digitally transformed image can be compared with the “later time captured image representing an actual cosmetic product treated body feature” (§ 0043). *Hawkins*’s disclosure of comparing predicted effects of a treatment with an actual treated body feature does not teach the “processing” feature of claim 54. That is, comparing a digital transformation showing predicted effects of a treatment and an image showing actual effects of a treatment, as disclosed by *Hawkins*, does not constitute processing a first image of an external body condition and a second image of the condition, captured after the subject has used a beauty product, to accentuate differences between those images, as claimed.

Because *Hawkins* does not teach each and every element of claim 54, as a matter of law, it cannot anticipate that claim. The rejection of claim 54 under 35 U.S.C. §102(a) based on *Hawkins* should therefore be reversed.

6. Claims 32-38

The Final Office Action failed to establish that *Hawkins* teaches each and every feature of claims 32-38. Specifically, the Final Office Action failed to establish that *Hawkins* teaches the following features recited in claim 32 and required by dependent claims 33-38:

distributing at least one cosmetic product to the beauty facility;

instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product; [and]

instructing the beauty facility to display to the customer the before and after images so that the customer may be provided with a visual indication of progress.

The Examiner alleged that "[s]electing the cosmetic product at the sales counter . . . inherently indicates *distributing* said cosmetic product to the point of sale [and that] . . . use of said method, disclosed by *Hawkins*, inherently indicates *instructing* a business entity to perform said method steps." Final Office Action at 10. The Examiner has not established that *Hawkins* expressly describes the above-noted features of claims 32-38. Further, the Examiner has not established inherency.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

In this case, the Final Office Action fails to provide sufficient evidence from *Hawkins*, or any recourse to extrinsic evidence, that makes clear that the subject matter of claims 32-38 is necessarily present in the reference. Further, the Final Office Action

fails to present sufficient factual basis and technical reasoning to demonstrate inherency. That *Hawkins* allegedly mentions “[s]electing the cosmetic product at the sales counter” does not evidence that the recitation of “distributing at least one cosmetic product to the beauty facility” is necessarily present in *Hawkins*. In addition, the Final Office Action provides no factual basis and technical reasoning to support the allegation that use of *Hawkins*’s method indicates instructing a business entity to perform the claimed method. Consequently, the Examiner cannot properly infer that the subject matter of claims 32-38 is inherently disclosed by *Hawkins*. For at least these reasons, the rejection of claims 32-38 under 35 U.S.C. §102(a) based on *Hawkins* should be reversed.

C. The rejection of claim 45 under 35 U.S.C. § 102(e) based on *Maloney* should be reversed because *Maloney* does not anticipate that claim

1. *Maloney* is not prior art under 35 U.S.C. § 102(e)

As an initial matter, Appellants submit that the rejection of claim 45 under 35 U.S.C. § 102(e) is improper because *Maloney* is based on an international application filed before November 29, 2000, and is therefore not prior art under § 102(e). Given *Maloney*’s potential relevance under § 102(a), however, Appellants address *Maloney*’s application to claim 45 below.

2. *Maloney* does not anticipate claim 45 because it does not teach each and every feature of the claim

The Final Office Action fails to show that *Maloney* teaches at least the following features of claim 45:

enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information; and

causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record.

Although *Maloney* mentions collecting profiling data (pages 6-7), the reference does not teach enabling a data structure to maintain “a historical record of at least some of the recorded cosmetic product usage information and personal information,” as claimed. Furthermore, *Maloney*’s profiling data does not include “product usage information.” *Maloney* merely mentions collecting “preferred colors and styles, lifestyle, life stage, attitude, desired look of hair, desired look of face and level of involvement” (page 7). The Examiner alleged that *Maloney* discloses personalized data including purchasing choices and product types. Final Office Action at 21. Even if that allegation were valid, purchasing information and product type information do not constitute “product usage information,” as claimed.

Maloney further lacks disclosure of the above-noted “causing” feature of claim 45. In *Maloney*’s system, a user “is provided with a list of one or more products . . . that correspond to the consumer profiling category” (pages 7, 9). *Maloney* does not disclose using at least a portion of a historical record, which includes recorded cosmetic product usage information and personal information, to generate at least one product recommendation.

For at least the foregoing reasons, *Maloney* does not teach each and every feature of claim 45. Accordingly, *Maloney* cannot anticipate claim 45 and the § 102(e)

rejection of that claim should be reversed. *See Verdegaa Bros.*, 814 F.2d at 631, 2 USPQ2d at 1053.

D. The rejection of claim 28 under 35 U.S.C. § 103(a) based on *Hawkins* should be reversed because a case for *prima facie* obviousness has not been established

The rejection of claim 28 under 35 U.S.C. § 103(a) should be reversed because a case for *prima facie* obviousness has not been established. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner must show first that the prior art references teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Second, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner resulting in the claimed invention. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Third, the Examiner must show that there is a reasonable expectation of success to modify or combine. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Moreover, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the Applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

In this case, *prima facie* obviousness has not been established with respect to claim 28 at least because (1) *Hawkins* does not teach or suggest all of the features recited in claim 28; and (2) the Examiner failed to provide a proper motivation to modify *Hawkins* in a manner resulting in Appellants’ claimed invention.

1. The Examiner failed to establish that *Hawkins* teaches or suggests each and every feature of claim 28

Claims 28 depends upon claim 5 and therefore includes all of the features recited in claim 5, including “facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image.” For at least reasons similar to those presented above in connection with claim 5, the Examiner has not established that *Hawkins* teaches or suggests this “facilitating” feature.

Furthermore, the Examiner has not established that *Hawkins* teaches or suggests “encouraging the beauty facility to recommend to the subject that the subject capture and store the second image on the recordable media at a location remote from the beauty facility,” as recited in claim 28. Indeed, while alleging that *Hawkins* discloses capturing images at a beauty facility or a user’s home, the Examiner conceded that *Hawkins* fails to disclose the “encouraging” feature of claim 28. See Final Office Action at 13.

The Final Office Action fails to show that claim 28, as a whole, including the “facilitating” and “encouraging” subject matter would have been obvious. Indeed, the allegations in the Office Action that *Hawkins* teaches certain subject matter do not suffice to establish a *prima facie* conclusion of obviousness. See *id.*

2. The Examiner failed to establish that a skilled artisan would have modified *Hawkins* in a manner resulting in Appellants’ claimed combination

In rejecting claim 28, the Examiner alleged that “[i]t is old and well known that if some task can be performed at home rather than at the remote facility, it is convenient

to perform said task at home.” Final Office Action at 13. In an attempt to establish a case for *prima facie* obviousness, the Examiner further alleged that it would have been obvious to a skilled artisan to modify *Hawkins* to include the missing feature “because it would be convenient for the consumer to take the second image at the time suitable for the consumer.” *Id.*

The Examiner failed to establish a proper motivation for modifying *Hawkins*. The Federal Circuit has opined that “virtually all [inventions] are combinations of old elements.” *See e.g., In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

Also, determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Additionally, the Federal

Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be "clear and particular." *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Final Office Action does not show that a skilled artisan considering *Hawkins*, and not having the benefit of Appellants' disclosure, would have been motivated to modify *Hawkins* in a manner resulting in Appellants' claimed combination. The Examiner's allegations regarding obviousness are completely conclusory and unsupported by any evidence on the record. For example, the Examiner pointed to no mention in *Hawkins* of the alleged consumer convenience. Further, the Examiner failed to provide substantial evidence on the record to show that the convenience of performing tasks at home was well-known, or to show that the "encouraging" features of claim 28 were well-known. See M.P.E.P. § 2144.03.

To the extent the Examiner is relying on Official Notice to support the above-noted conclusions regarding "old and well known" subject matter, Appellants call attention to the provisions of M.P.E.P. § 2144.03 and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. M.P.E.P. § 2144.03 sets forth that "the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" Further, any facts asserted as well-known should serve only to "fill in the gaps" in an insubstantial manner. It is never appropriate to rely solely on "common

knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based.

Appellants submit that the features of claim 28 were not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. As M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). The Office Action does not provide substantial evidence on the record to show that Appellants’ claimed features were unquestionably well-known. Indeed, the Examiner failed to provide either a competent prior art reference to substantiate the conclusions of obviousness in the Final Office Action or “an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” See M.P.E.P. § 2144.03 (emphasis added).

In addition to being unsupported, the conclusory allegations in the Final Office Action do not establish that it would have been obvious to modify *Hawkins* to perform the “encouraging” feature (or the “facilitating capture and storage” feature) of claim 28. Appellants point out that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is “basic knowledge” or “common sense.”” *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (Fed. Cir. 2001) (emphasis added). Appellants submit that, in this case, the Examiner is improperly attempting to cure the

deficiencies of *Hawkins* with general conclusions that certain subject matter is “well known” and “convenient.”

Appellants also note that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02 (*citing Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)). Here, the Examiner has not shown that claim 28, as a whole, would have been obvious in view of *Hawkins*. Even if the convenience of performing a task at home were obvious or well known, the Examiner failed to establish that claim 28 as a whole, including “encouraging the beauty facility to recommend to the subject that the subject capture and store the second image on the recordable media at a location remote from the beauty facility,” would have been obvious. Indeed, the Examiner merely alleged that *Hawkins* discloses certain elements and that certain elements are “old and well known,” without showing reasons that a skilled artisan would select or modify those elements in the manner claimed and also without showing that the claimed invention as a whole would have been obvious. The conjectural conclusions set forth in the Final Office Action do not suffice to establish a *prima facie* conclusion of obviousness.

Simply because references can be combined or modified does not render their combination obvious unless the references also suggest the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner can satisfy the burden of establishing a *prima facie* case of obviousness “only

by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to [modify or] combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citations omitted) (emphasis added). The Federal Circuit has reaffirmed the Examiner’s high burden associated with establishing a *prima facie* case of obviousness and has emphasized the requirement of specificity. See *In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). In this case, the Examiner failed to show with the required specificity that the cited art “suggests the desirability of the” modification.

Appellants submit that the conclusions in the Final Office Action are based on improper hindsight reasoning. The Federal Circuit has specifically admonished that taking “the inventor’s disclosure as a blueprint” is “the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). The Court has further warned that an “inventor’s explanation of how the invention works does not render obvious that which is otherwise unobvious.” *In re Glaug*, 283 F.3d 1335, 1342, 62 USPQ2d 1151, 1155 (Fed. Cir. 2002). These admonitions and warnings are “especially important in the case of less technically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 (quotation omitted).

Appellants submit that the conclusions in the Final Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. While *Hawkins* might mention capturing images, the reference does not teach or suggest modifying its teachings as alleged in the Final Office Action.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 28. The § 103(a) rejection of that claim should therefore be reversed.

E. The rejection of claim 25 under 35 U.S.C. § 103(a) based on *Hawkins* and AS/400 should be reversed because a case for *prima facie* obviousness has not been established

A case for *prima facie* obviousness has not been established with respect to claim 25 at least because (1) *Hawkins* and AS/400 do not teach or suggest all of the features recited in claim 25; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

1. The Examiner failed to establish that *Hawkins* and AS/400 teach or suggest each and every feature of claim 25

Claims 25 depends upon claim 5 and therefore includes all of the features recited in claim 5, including "facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image." For at least reasons similar to those presented above in connection with claim 5, the Examiner has not established that *Hawkins* teaches or suggests this "facilitating" feature.

In addition, the Examiner has not established that AS/400 cures *Hawkins*'s deficiencies. Indeed, the AS/400 CD image does not teach or suggest the "facilitating capture and storage" features of claim 5. Accordingly, neither *Hawkins* nor AS/400, nor any combination thereof, teaches or suggests all of the elements of claims 25. For at least this reason, the § 103(a) rejection of claim 25 should be reversed.

2. The Examiner failed to establish that a skilled artisan would have modified or combined *Hawkins* and AS/400 in a manner resulting in Appellants' claimed combination

In rejecting claim 25, the Examiner alleges that *Hawkins* inherently indicates "use of a tangible recording media" and that a skilled artisan would have modified *Hawkins* so that the "tangible recording media includes a *visible marking* identifying a distributor," as allegedly disclosed by AS/400. Final Office Action at 13-14. According to the Examiner, a skilled artisan would have modified *Hawkins* "because it would promote [the] distributor's products" *Id.* at 14. The Final Office Action does not show that a skilled artisan considering the cited art, and not having the benefit of Appellants' disclosure, would have been motivated to modify *Hawkins* as alleged.

To begin with, the Final Office Action fails to provide sufficient evidence from *Hawkins*, or any recourse to extrinsic evidence, that makes clear that the "tangible recording media" subject matter of claim 25 is necessarily present in the reference. Further, the Final Office Action fails to present sufficient factual basis and technical reasoning to demonstrate inherency. That *Hawkins* allegedly mentions "displaying . . . images on a computer monitor" does not evidence that the "tangible recording media" subject matter of claim 25 is necessarily present in *Hawkins*. Consequently, the

Examiner cannot properly infer that the subject matter of claim 25 is inherently disclosed by *Hawkins*. See M.P.E.P. § 2112.

Furthermore, the Examiner has not shown that a skilled artisan considering *Hawkins* and AS/400, and not having the benefit of Appellants' disclosure, would have been motivated to modify *Hawkins* in a manner resulting in Appellants' claimed combination. The Examiner's allegations regarding obviousness are conclusory and unsupported by any evidence on the record. Indeed, the Examiner points to no mention in the cited art, or in the knowledge generally available to a skilled artisan, regarding the alleged "[promotion of the] distributor's products."

Even if visible markings identifying a distributor were obvious or well known, the Examiner failed to establish that claim 25 as a whole would have been obvious. See M.P.E.P. § 2141.02. Appellants submit that the conclusions in the Final Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. The cited references do not teach or suggest modifying their respective teachings as alleged in the Final Office Action. Appellants submit that the Examiner is impermissibly using hindsight to piece together isolated disclosures of the cited references, which constitutes improper hindsight reconstruction. See *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For at least these additional reasons, *prima facie* obviousness has not been established and the § 103(a) rejection of claim 25 should be reversed.

F. The rejection of claims 39-44, 58, and 59 under 35 U.S.C. § 103(a) based on *Maloney* should be reversed because a case for *prima facie* obviousness has not been established

A case for *prima facie* obviousness has not been established with respect to claims 39-44, 58, and 59 at least because the Examiner failed to provide a proper motivation to modify *Maloney* in a manner resulting in Appellants' claimed invention.

1. Claims 39-43 and 58

With regard to independent claim 39, the Examiner conceded that *Maloney* fails to disclose "a transportable computer-readable media." Final Office Action at 14. In rejecting claim 39, the Examiner alleged, noting certain disclosures in *Maloney*, that "[i]t is old and well known that computer-readable media can be . . . transportable." *Id.* The Examiner further alleged that a skilled artisan would have modified *Maloney* to enable a subject to record personal beauty information on a transportable medium "because it would advantageously allow . . . use [of] this method in geographical locations where network communication is not available." The Examiner has not established the requisite motivation to modify *Maloney*, as discussed below.

The Final Office Action does not show that a skilled artisan considering *Maloney*, and not having the benefit of Appellants' disclosure, would have been motivated to modify *Maloney's* system in a manner resulting in Appellants' claimed combination. These allegations by the Examiner regarding motivation are completely conclusory and unsupported by any evidence on the record. For example, the Examiner points to no mention in *Maloney* of the alleged use "in geographical locations where network communication is not available." Further, the Examiner provided no evidence or

reasoning showing that transportable medium would allow use of *Maloney's* method "in geographical locations where network communication is not available."

Even if transportable computer-readable media were old and well known, as alleged by the Examiner, *prima facie* obviousness has not been established. Section 2141.02 of the M.P.E.P. makes clear, as noted above, that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). Assuming *arguendo* that transportable computer-readable media were obvious or well known, the Examiner failed to establish that claim 39 as a whole, including "enabling a subject to record personal beauty information on a transportable medium" and "enabling a plurality of beauty facilities to read the information on the transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities," would have been obvious. Appellants submit that the Examiner is improperly using Appellants' claims in hindsight to reconstruct the prior art.

For at least the reasons noted above, *prima facie* obviousness has not been established with respect to claim 39. The § 103(a) rejection of that claim should therefore be reversed. The § 103(a) rejection of claims 40-43 and 58 should be reversed as well, at least because those claims depend upon claim 39. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

2. Claims 44 and 59

Independent claim 44 recites, *inter alia*, "enabling a beauty facility to record on transportable medium personal beauty information about a subject." The Examiner

conceded that *Hawkins* fails to disclose transportable computer-readable media. Final Office Action at 15. In an attempt to establish *prima facie* obviousness, the Examiner alleged that transportable computer-readable media were old and well known and that a skilled artisan would have modified *Maloney's* system "because it would advantageously allow . . . use [of] this method in geographical locations where network communication is not available." *Id.*

For at least reasons similar to those set forth above for claim 39, the Final Office Action does not establish *prima facie* obviousness with respect to claim 44. The § 103(a) rejection of claim 44 should therefore be reversed. Additionally, the § 103(a) rejection of claim 59 should be reversed, at least because that claim depends upon claim 44. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

G. The rejection of claims 46 and 47 under 35 U.S.C. § 103(a) as based on *Cohen* and *Maloney* should be reversed because a case for *prima facie* obviousness has not been established

A case for *prima facie* obviousness has not been established with respect to claims 46 and 47 at least because (1) *Cohen* is nonanalogous art and thus an improper reference under § 103(a); (2) *Cohen* and *Maloney* do not teach or suggest all of the features recited in claims 46 and 47; and (3) the Examiner failed to provide a proper motivation to modify or combine the cited references in a manner resulting in Appellants' claimed invention.

1. *Cohen* is nonanalogous art and thus an improper reference under 35 U.S.C. § 103(a)

In order to rely upon a reference under Section 103, the reference must be analogous prior art. See M.P.E.P. § 2141.01(a). According to the Federal Circuit, the inquiry as to whether a reference is analogous prior art is:

(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Contrary to the Examiner's allegations, *Cohen* is not in the same field of endeavor as Appellants' claimed invention and is not reasonably pertinent to the particular problem addressed by Appellants' claims. See Final Office Action at 22. *Cohen* relates to incentivizing use of exercise equipment and is dissimilar to claims 46 and 47, which are directed to a beauty advisory method. Indeed, *Cohen* explains that the "invention relates to exercise equipment and computer networking" (¶ 0003). Further, *Cohen* would not logically have commended itself to an inventor's attention in considering the problems associated with cosmetic product usage and providing beauty advice to subjects. *Cohen* thus should be regarded as nonanalogous art and should not be used as a reference against the present application under 35 U.S.C. § 103(a). See M.P.E.P. § 2141.01(a).

2. The Examiner failed to establish that *Cohen* and *Maloney* teach or suggest each and every feature of claims 46 and 47

Even if *Cohen* is deemed a proper reference within the context of 35 U.S.C. § 103(a), *Cohen* and *Maloney* do not teach or suggest each and every feature recited in claim 46 and required by its dependent claim 47.

Claim 46 recites a combination including:

comparing the recorded information [about the subject's cosmetic product usage and about the subject's lifestyle] with a database of information on cosmetic usage and lifestyles of a plurality of individuals; [and]

causing, when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject.

Although *Cohen* mentions "[u]sage-based pricing of equipment," the reference does not teach or suggest the claimed "comparing." Also, *Cohen* does not disclose or suggest the claimed "causing." In fact, *Cohen* does not mention "a cosmetic product," as affirmed by the Examiner, let alone the claimed "comparing" and "causing." Final Office Action at 16.

Maloney does not cure *Cohen*'s deficiencies. *Maloney* mentions determining a profiling category for a consumer based on profiling information and providing a list of products corresponding to the category (pgs. 7, 9). *Maloney* fails to disclose causing a product to be recommended to a subject "when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle," as claimed. Because the applied references do not teach or suggest each

and every feature of claim 46 (and its dependent claim 47), a *prima facie* case of obviousness has not been established.

3. The Examiner failed to establish that a skilled artisan would have modified or combined *Cohen* and *Maloney* in a manner resulting in Appellants' claimed combination

A case for *prima facie* obviousness has not been established with respect to claims 46 and 47 because the requisite motivation to combine *Cohen* and *Maloney* is lacking. The Examiner has not shown by evidence that a skilled artisan considering the cited references, and not having the benefit of Appellants' disclosure, would have been motivated to modify or combine the references.

As noted above, in rejecting claim 46, the Examiner conceded that *Cohen* fails to disclose a cosmetic product. Indeed, *Cohen* relates to incentivizing use of exercise equipment. In an attempt to establish a case for *prima facie* obviousness, the Examiner alleged that *Maloney* teaches "providing a customized *cosmetic* product" and further that a skilled artisan would have modified *Cohen*'s system such that it offers cosmetic products rather than exercise equipment. According to the Examiner, a skilled artisan would have modified *Cohen* "because it would advantageously expand a line of products and bring more customers to the business, [and] thereby increase revenue." Final Office Action at 16.

The Examiner's allegations regarding obviousness are conclusory and unsupported by any evidence on the record. Indeed, the Examiner points to no mention in the cited art, or in the knowledge generally available to a skilled artisan, regarding the alleged product line expansion, increase in customers, or increase in revenue. The

conjectural conclusions set forth in the Final Office Action do not suffice to establish a *prima facie* conclusion of obviousness. Appellants note that the Examiner must cite facts in support of each requirement for a Section 103 rejection and not merely recite the Examiner's opinion. Further, the Federal Circuit has explained that "[w]ith respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board must point to some concrete evidence in the record in support of these findings." *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added).

Even if *Cohen* and *Maloney* were to disclose the various features alleged by the Examiner, the Examiner failed to establish that the invention defined by claim 46 as a whole would have been obvious. See M.P.E.P. § 2141.02. Appellants submit that the conclusions in the Final Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. Appellants submit that only in hindsight could a skilled artisan having the cited references before him combine their teachings in the manner claimed with a reasonable expectation of success. While *Cohen* mentions "[u]sage-based pricing of equipment" and *Maloney* mentions cosmetic products, the cited references do not teach or suggest modifying their respective teachings as alleged in the Final Office Action. Appellants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of dissimilar references. Examiners, however, may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention. Such picking

and choosing amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For at least these additional reasons, *prima facie* obviousness has not been established with respect to claim 46. The § 103(a) rejection of that claim, and dependent claim 47, should therefore be reversed.

H. The rejection of claims 31, 49, 51-53, and 55-57 under 35 U.S.C. § 103(a) based on *Hawkins* and *Maloney* should be reversed because a case for *prima facie* obviousness has not been established

A case for *prima facie* obviousness has not been established with respect to claims 31, 49, 51-53, and 55-57 for at least the following reasons.

1. Claim 31

A case for *prima facie* obviousness has not been established with respect to claim 31 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claim; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS* AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY FEATURE OF CLAIM 31

Independent claim 31 recites, *inter alia*:

establishing a subject record, the record including the first image . . .

associating . . . at least one second image with the subject record; and

providing the subject with viewing access to the subject record.

The Final Office Action fails to establish that *Hawkins* and *Maloney* teach or suggest at least the above-noted features. In fact, the Examiner's rejection of claim 31 does not even address these features. See Final Office Action at 16-17. Indeed, although *Hawkins* mentions "capturing" images, (¶¶ 0039, 0041), the reference does not teach or suggest the "subject record" features noted above. *Maloney* does not cure *Hawkins*'s deficiencies. Although *Maloney* mentions collecting personalized data about consumers, the references does not disclose the "subject record" features of claim 31. Because the applied references do not teach or suggest each and every feature of claim 31, a *prima facie* case of obviousness has not been established and the § 103(a) rejection should be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS' CLAIMED COMBINATION

The Final Office Action does not show by substantial evidence that a skilled artisan considering the *Hawkins* and *Maloney*, and not having the benefit of Appellants' disclosure, would have been motivated to modify or combine the references in a manner resulting in the invention defined by claim 31. The Examiner alleged that a skilled artisan would have modified *Hawkins* "to include recommending a list of products which should achieve the desired look based on the determined differences . . . because it would advantageously allow the consumer to achieve the desired look." Final Office Action at 17. These allegations by the Examiner are unsupported by evidence on

the record and do not establish that a skilled artisan would have modified or combined *Hawkins* and *Maloney* in a manner resulting in the invention defined by claim 31. For example, the Examiner failed to provide any evidence or reasoning to show how the alleged modification would “advantageously allow the consumer to achieve the desired look.” As noted above, simply because references can be combined or modified does not render their combination obvious unless the references also suggest the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, the Examiner failed to show with the required specificity that the cited art “suggests the desirability of the” modification.

For at least these additional reasons, *prima facie* obviousness has not been established with respect to claim 31. The § 103(a) rejection of that claim should therefore be reversed.

2. Claims 49, 60, and 61

A case for *prima facie* obviousness has not been established with respect to claims 49, 60, and 61 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claims; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants’ claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS* AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY FEATURE OF CLAIM 49

With regard to independent claim 49, the Examiner failed to establish that *Hawkins* teaches or suggests “analyzing the first and second information to determine

an extent of differences that occurred in the body condition between the first and second time frames,” as claimed. Indeed, although *Hawkins* mentions “allowing the consumer to compare results between . . . images” (§ 0042), the reference does not teach “analyzing . . . first and second information to determine an extent of differences that occurred in the body condition,” as claimed. Further, “digitally [transforming an image] . . . to demonstrate [predicted] effects of a cosmetic product treatment,” as disclosed by *Hawkins* (§§ 0043-0044), does not anticipate “analyzing . . . first and second information to determine an extent of differences that occurred in the body condition,” as claimed. Contrary to the Examiner’s position, in *Hawkins*’s system, an image is digitally transformed to demonstrate a predicted effect, not to analyze information to determine an extent of differences that occurred in the body condition. See Final Office Action at 17.

The Examiner further failed to establish that *Hawkins* teaches or suggests “prescribing at least one beauty product based on the extent of determined differences,” as recited in claim 49. Indeed, the Examiner conceded to that *Hawkins* fails to disclose this feature. See Final Office Action at 17.

Maloney does not cure *Hawkins*’s deficiencies. The Examiner alleged that *Maloney* discloses “providing [a] virtual image of the subject to demonstrate (determine) a result of use of cosmetic product.” *Id.* Appellants disagree with the Examiner’s interpretation of *Maloney*. Even if *Maloney*’s system were to provide a virtual image to demonstrate a result of using a product, such functionality does not constitute “analyzing . . . first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames,” as claimed.

Contrary to the Examiner's position, demonstrating a result, as described by *Maloney*, is not the same as analyzing information to determine an extent of differences, as claimed.

Additionally, the Examiner failed to establish that *Maloney* discloses "prescribing at least one beauty product based on the extent of determined differences," as recited in claim 49. Indeed, *Maloney* does not teach or suggest determining an extent of differences, as explained above, let alone prescribing at least one beauty product based on the extent of determined differences, as claimed.

Because the applied references do not teach or suggest each and every feature of claim 49, a *prima facie* case of obviousness has not been established. Accordingly, the § 103(a) rejection of claim 49 should be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS' CLAIMED COMBINATION

In rejecting claim 49, the Examiner alleged that a skilled artisan would have modified *Hawkins* in view of *Maloney* in a similar fashion as that described with respect to claim 31 and for the same reasons as those presented for claim 31. Although claim 49 is of different scope than claim 31, the Examiner failed to establish that a skilled artisan would have modified *Hawkins* in a manner resulting in the invention defined by claim 49 for at least reasons similar to those presented above in connection with claim 31. Further, Appellants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the cited references. For at least these additional reasons, *prima facie* obviousness has not

been established with respect to claim 31. The § 103(a) rejection of that claim should therefore be reversed.

Each of claims 60 and 61 depends upon claim 49. The § 103(a) rejection of those claims should be reversed for at least the same reasons set forth above in connection with claim 49.

3. Claims 51 and 52

A case for *prima facie* obviousness has not been established with respect to claims 51 and 52 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claims; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS* AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY FEATURE OF CLAIMS 51 AND 52

Each of claims 51 and 52 depends upon claim 50 and therefore requires the "providing instructions for storage of third information relating to behavior of a subject" feature recited in claim 50. For at least reasons similar to those presented above in connection with claim 50, the Examiner has not established that *Hawkins* teaches or suggests this feature.

Additionally, the Examiner has not established that *Maloney* cures *Hawkins*'s deficiencies. Indeed, *Maloney* does not disclose or suggest "providing instructions for storage of third information relating to behavior of a subject between the first and second time frames," as recited in claim 50 and required by claims 51 and 52. Accordingly, neither *Hawkins* nor *Maloney*, nor any combination thereof, teaches or

suggests all of the elements of claims 50-52. For at least this reason, the § 103(a) rejection of claims 51 and 52 should be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS' CLAIMED COMBINATION

The Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention. In rejecting claim 51, the Examiner alleged that a skilled artisan would have modified *Hawkins* such that "access to [a] consumer's personal data is controlled by the consumer . . . because it would advantageously enhance security of the system." Final Office Action at 18. This allegation by the Examiner is not properly supported and does not establish that a skilled artisan would have combined the cited references as alleged or in a manner yielding the "providing instructions for storage of third information relating to behavior of a subject" feature recited in claim 50. For example, the Examiner's allegation that modifying *Hawkins* "would advantageously enhance security of the system" is unsupported by evidence on the record. The Examiner fails to show this alleged motivation to be present in the cited art or the knowledge generally available to a skilled artisan. The Examiner also pointed to no security vulnerabilities in *Hawkins*'s system and failed to establish that a skilled artisan considering *Hawkins* would be concerned with enhancing the security of the disclosed system. Appellants submit that the conclusions in the Final Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly

used in hindsight to reconstruct the prior art. For at least these additional reasons, the § 103(a) rejection of claim 51 should be reversed.

Claim 52 depends upon 51. Although claim 52 is of different scope than claim 51, the requisite motivation for modifying *Hawkins* in view of *Maloney* is lacking with respect to claim 52 for at least reasons similar to those presented above in connection with claim 51. For this additional reason, the § 103(a) rejection of claim 52 should be reversed.

4. Claim 53

A case for *prima facie* obviousness has not been established with respect to claim 53 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claim; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS* AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY FEATURE OF CLAIM 53

Claim 53 depends upon claim 1 and thus requires the "facilitating storage of information reflecting the subject's usage of the beauty product" feature recited in claim 1. For at least the reasons presented above in connection with claim 1, *Hawkins* fails to teach or suggest this feature. *Hawkins* further fails to teach or suggest "presenting to the subject at least one depiction of data quantifying an effectiveness of the beauty product based on the first information, the second information, and at least part of the stored information," as recited in claim 53. Contrary to the Examiner's allegation (Final Office Action at 18), displaying a digital transformation showing predicted effects of a

treatment, as disclosed by *Hawkins*, does not teach or suggest the claimed “presenting.”

Maloney does not cure *Hawkins*’s deficiencies. Although *Maloney* describes providing customized products to consumers, the reference does not disclose “facilitating storage of information reflecting the subject’s usage of the beauty product,” as recited in claim 1 and required by claim 53. *Maloney* also lacks disclosure of the “presenting” feature of claim 53. In fact, the Final Office Action does not make clear how *Maloney* is being applied (if at all) to claim 53, since base claim 1 was rejected based on *Hawkins* alone and the rejection of claim 53 does not specifically address *Maloney*. See Final Office Action at 18. For at least these reasons, the Examiner has not established that *Maloney* and *Hawkins*, taken alone or in combination, teach or suggest each and every feature of claim 53. The § 103(a) rejection of claim 53 should thus be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS’ CLAIMED COMBINATION

The Final Office Action fails to provide a proper motivation to modify or combine *Hawkins* and/or *Maloney* in a manner resulting in the invention defined by claim 53. In fact, as explained above, the Final Office Action does not make clear how *Maloney* is being applied (if at all) to claim 53. For these additional reasons, the § 103(a) rejection of claim 53 should be reversed.

5. Claim 55

A case for *prima facie* obviousness has not been established with respect to claim 55 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claim; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS* AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY FEATURE OF CLAIM 55

Claim 55 depends upon claim 5 and thus requires the "facilitating capture and storage of information reflecting usage of at least one of the beauty products" feature recited in claim 5. For at least the reasons presented above in connection with claim 5, the Examiner has not established that *Hawkins* teaches or suggests this feature.

Furthermore, *Hawkins* does not teach or suggest "processing the first and second images of the external body condition of the subject to detect differences between said images" and "providing advice to a subject based on the detected differences and based on personal information associated with the subject," as recited in claim 55. Although *Hawkins* discloses capturing images before and after application of a product (¶¶ 0039, 0041) and digitally transforming the before image "in accordance with a predicted effect" of a cosmetic product treatment (¶¶ 0043, see claims 1, 5-7), *Hawkins* does not teach or suggest "processing" and "providing advice," as claimed. Digitally transforming an image to display a predicted effect does not constitute processing two captured images to detect differences between those images, let alone providing advice. Moreover, *Hawkins*'s disclosure that the digitally transformed image

can be compared with the “later time captured image representing an actual cosmetic product treated body feature” (¶ 0043) does not constitute the claimed “processing” and “providing advice” features. *Hawkins*’s system merely allows a comparison between a digitally transformed image and another image showing actual results. *Hawkins* does not disclose “processing” the images to “detect differences,” let alone providing advice based on those detected differences and personal information associated with the subject, as recited in claim 55. Allowing a comparison is not the same as “processing” to “detect differences.”

Maloney does not cure *Hawkins*’s deficiencies. Although *Maloney* describes providing customized products to consumers, the reference does not disclose the “facilitating capture and storage of information reflecting usage of at least one of the beauty products” feature recited in claim 5 and required by claim 55.

Moreover, *Maloney* fails to disclose or suggest “processing the first and second images” and “providing advice,” as recited in claim 55. The Examiner alleged that *Maloney* discloses “providing personal information . . . including capturing an image of the subject” and “providing [a] virtual image to demonstrate . . . a result of use of a cosmetic product.” Final Office Action at 18 (*citing Maloney*, page 20, lines 27-29; page 26, claim 20). The Examiner also alleged that *Maloney* discloses “providing . . . advice to the subject based on said personal information . . . and said result.” *Id.*

Contrary to the Examiner’s position, *Maloney*’s disclosure that “an image of the consumer is displayed and the consumer can make product selections and the virtual results are displayed on the image of the consumer” does not constitute “processing the first and second images of the external body condition of the subject to detect

differences between said images,” as recited in claim 55. Final Office Action at 18 (citing *Maloney*, page 20, lines 27-29; page 26, claim 20). To the extent *Maloney*’s consumer image “demonstrate[s] . . . a result of use of a cosmetic product,” as alleged by the Examiner, the image merely demonstrates “virtual results,” which “depict how the products will look on the consumer.” *Maloney*, page 20, lines 27-29. *Maloney*’s “virtual results” displayed on the consumer image do not reflect detected differences between two images of an external body condition. Indeed, presenting virtual results on an image, as disclosed by *Maloney*, does not constitute “processing” external body condition images “to detect differences between said images,” as recited in claim 55.

In addition, contrary to the Examiner’s position, *Maloney* does not teach or suggest “providing . . . advice to the subject based on said personal information . . . and said result.” The cited portion of *Maloney* merely mentions displaying virtual results on an acquired image of a consumer and providing “a list of products which should achieve the desired look” based on the consumer’s alteration of the image. See Final Office Action at 18; *Maloney*, page 20, lines 27-29; page 26, claim 20. This functionality, as disclosed by *Maloney*, does not constitute “providing advice to a subject based on the detected differences and based on personal information associated with the subject,” as recited in claim 55. Indeed, *Maloney* does not disclose or suggest detecting differences between external body condition images, let alone providing advice based on those detected differences, as claimed. Further, even if *Maloney* were to disclose “providing . . . advice to the subject based on said personal information . . . and said result,” such functionality would not teach or suggest the “providing advice” feature of claim 55. That is, providing advice based on personal information and results, displayed on a

consumer image, depicting how products will look, is not the same as “providing advice to a subject based on the detected differences and based on personal information associated with the subject,” as recited in claim 55.

For at least these reasons, the Final Office Action does not establish that *Maloney* and *Hawkins*, taken alone or in combination, teach or suggest each and every feature of claim 55. As such, the § 103(a) rejection of claim 55 should be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS' CLAIMED COMBINATION

The Final Office Action fails to provide a proper motivation to modify or combine *Hawkins* and/or *Maloney* in a manner resulting in the invention defined by claim 55. The Examiner alleged that a skilled artisan would have combined the references “to advantageously allow the consumer to achieve the desired look.” Final Office Action at 18. This allegation by the Examiner is not properly supported and does not establish that a skilled artisan would have combined the cited references as alleged or in a manner yielding the features recited in claim 55. For example, despite *Maloney*'s mention of providing a list of products to “achieve the desired look,” the Examiner has not established that either *Maloney* or *Hawkins* suggests combining their respective teachings in the manner claimed.

Appellants submit that the conclusions in the Final Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. Appellants submit that only in hindsight could a skilled artisan having the cited

references before him combine their teachings in the manner claimed with a reasonable expectation of success. Appellants submit that the Examiner is again impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of dissimilar references. For at least these additional reasons, the § 103(a) rejection of claim 55 should be reversed.

6. Claim 56

A case for *prima facie* obviousness has not been established with respect to claim 56 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claim; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS* AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY FEATURE OF CLAIM 56

Claim 56 depends upon claim 5 and thus requires the "facilitating capture and storage of information reflecting usage of at least one of the beauty products" feature recited in claim 5. For at least the reasons presented above in connection with claim 5, the Examiner has not established that *Hawkins* teaches or suggests this feature.

Furthermore, *Hawkins* does not teach or suggest "determining a probable cause of a difference between the first and second images of the external body condition using personal information associated with the subject," as recited in claim 56. Although *Hawkins's* system allows a comparison between a digitally transformed image showing predicted results and another image showing actual results, contrary to the Examiner's apparent position, *Hawkins* does not teach or suggest "determining a probable cause of

a difference between the” images “using personal information associated with the subject,” as claimed. See Final Office Action at 18-19. Additionally, as affirmed by the Examiner, *Hawkins* does not teach or suggest “presenting to the subject the determined probable cause along with preventative measures,” as recited in claim 56.

Maloney does not cure *Hawkins*’s deficiencies. Although *Maloney* describes providing customized products to consumers, the reference does not disclose the “facilitating capture and storage of information reflecting usage of at least one of the beauty products” feature recited in claim 5 and required by claim 56.

Moreover, contrary to the Examiner’s position, *Maloney* fails to disclose or suggest the “determining a probable cause” and “presenting” features recited in claim 56. The Examiner alleged that *Maloney* discloses “providing personal information . . . including capturing an image of the subject” and “providing . . . a list of products which should achieve the desired look.” Final Office Action at 18 (*citing Maloney*, page 20, lines 27-29). Capturing an image and providing a list of products, as disclosed by *Maloney*, does not teach or suggest “determining a probable cause of a difference between the first and second images of the external body condition using personal information associated with the subject” and “presenting to the subject the determined probable cause along with preventative measures,” as recited in claim 56. Indeed, *Maloney* does not disclose or suggest these features of claim 56.

For at least these reasons, the Final Office Action does not establish that *Maloney* and *Hawkins*, taken alone or in combination, teach or suggest each and every feature of claim 56. As such, the § 103(a) rejection of that claim should be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS' CLAIMED COMBINATION

The Final Office Action fails to provide a proper motivation to modify or combine *Hawkins* and/or *Maloney*. The Examiner alleged that a skilled artisan would have combined the references “to advantageously allow the consumer to achieve the desired look.” Final Office Action at 19. This allegation by the Examiner is not properly supported and does not establish that a skilled artisan would have combined the cited references as alleged or in a manner yielding the features recited in claim 56. While *Maloney* mentions providing a list of products to “achieve the desired look,” the Examiner has not established that either *Maloney* or *Hawkins* suggests combining their respective teachings as alleged. Appellants submit that the Examiner is again impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the cited references. For at least these additional reasons, the § 103(a) rejection of claim 56 should be reversed.

7. Claim 57

The Examiner rejected claim 57 for the same reasoning applied to claim 55. See Final Office Action at 19. A case for *prima facie* obviousness has not been established with respect to claim 57 at least because (1) *Hawkins* and *Maloney* do not teach or suggest all of the features recited in the claim; and (2) the Examiner failed to provide a proper motivation to modify or combine the references in a manner resulting in Appellants' claimed invention.

a) THE EXAMINER FAILED TO ESTABLISH THAT *HAWKINS*
AND *MALONEY* TEACH OR SUGGEST EACH AND EVERY
FEATURE OF CLAIM 57

Claim 57 depends upon claim 32 and thus requires the “distributing at least one cosmetic product to the beauty facility” feature recited in claim 32. For at least the reasons explained above in connection with claim 32, the Examiner has not established that *Hawkins* discloses, inherently or otherwise, this feature.

The Examiner further failed to establish that *Hawkins* discloses or suggests “instructing the beauty facility to capture and store information reflecting a nature of the application of the at least one cosmetic product,” as recited in claim 57. Although *Hawkins* mentions “capturing” images before and after usage of a product (¶¶ 0039, 0041) and transforming images “in accordance with a predicted effect” to demonstrate effects of a cosmetic product treatment” (¶¶ 0043-0044), the reference does not teach or suggest “instructing the beauty facility to capture and store information reflecting a nature of the application of the at least one cosmetic product,” as recited in claim 57 (emphasis supplied). An image reflecting a predicted effect does not constitute information reflecting a nature of the application of at least one cosmetic product. In addition, capturing an image after application of a product does not constitute storage of information reflecting a nature of the application, as claimed. At best, *Hawkins*’s image captured after a product application would merely display results of that product application, it does not reflect a nature of the application of the product. For at least these reasons, *Hawkins* does not teach each and every feature of claim 57.

Maloney does not cure *Hawkins*’s deficiencies. Although *Maloney* describes providing customized products to consumers, the reference does not disclose the

“distributing” feature recited in claim 32 and required by claim 57. Moreover, *Maloney* fails to disclose “instructing the beauty facility to capture and store information reflecting a nature of the application of the at least one cosmetic product,” as recited in claim 57. *Maloney*’s disclosure that “an image of the consumer is displayed and the consumer can make product selections and the virtual results are displayed on the image of the consumer” does not teach or suggest the claimed “instructing.” Displaying virtual results on a captured image of a consumer is not the same as instructing a beauty facility to capture and store information reflecting a nature of an application of at least one cosmetic product. Additionally, *Maloney*’s disclosure of providing “a list of products which should achieve the desired look” based on the consumer’s alteration of the image does not teach or suggest the claimed “instructing.” Indeed, *Maloney* fails to teach or suggest at least the above-noted “distributing” and “instructing” features of claim 57.

Because the Final Office Action fails to establish that *Maloney* and *Hawkins*, taken alone or in combination, teach or suggest each and every feature of claim 57, a case for *prima facie* obviousness has not been established. As such, the § 103(a) rejection of claim 57 based on those references should be reversed.

b) THE EXAMINER FAILED TO ESTABLISH THAT A SKILLED ARTISAN WOULD HAVE MODIFIED OR COMBINED HAWKINS AND MALONEY IN A MANNER RESULTING IN APPELLANTS’ CLAIMED COMBINATION

The Final Office Action fails to provide a proper motivation to modify or combine *Hawkins* and/or *Maloney*. The Examiner rejected claim 57 for the same reasoning applied to claim 55. As explained above in connection with claim 55, however, the Examiner has not established that either *Maloney* or *Hawkins* suggests combining their

respective teachings as alleged. The Examiner also failed to establish that either *Maloney* or *Hawkins* suggests combining their respective teachings in a manner yielding all of the features of claim 57. Appellants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the cited references. For at least these additional reasons, the § 103(a) rejection of claim 57 should be reversed.

VIII. Conclusion

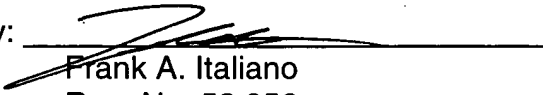
For the reasons given above, Appellants request that the Board of Patent Appeals and Interferences reverse the Examiner's rejections of pending claims 1-25 and 27-61 and place this application in condition for allowance.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 3, 2005

By: 
Frank A. Italiano
Reg. No. 53,056

IX. Appendix A: Listing of Claims Under Rule 41.37(c)(1)(viii)

1. (Original) A beauty care method, comprising:
obtaining first information representative of an external body condition of a subject;
obtaining second information representative of the external body condition of the subject after the subject uses a beauty product;
facilitating storage of information reflecting the subject's usage of the beauty product; and
enabling the subject to view the first information, the second information, and at least part of the stored information.
2. (Original) The method of claim 1, wherein at least one of the first information and the second information is an image of the external body condition.
3. (Original) The method of claim 1, wherein each of the first information and the second information includes an image of the external body condition.
4. (Original) The method of claim 1, conducted in a network environment, wherein obtaining the first information and obtaining the second information occurs over a network and at a location remote from the subject.

5. (Original) A beauty care method, comprising:

providing information about beauty products;

facilitating electronic capture of a first image of an external body condition of a subject;

encouraging the subject to use at least one of the beauty products;

facilitating, after the subject has used the at least one beauty product, electronic capture of a second image of the external body condition of the subject, wherein capture of at least one of the first and second images occurs at a beauty facility;

facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image; and

enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured.

6. (Original) The method of claim 5, wherein providing information about beauty products includes at least one of offering beauty products for sale directly to consumers, offering beauty products for sale to consumers via a retail sales establishment, and offering beauty products through beauty facilities.

7. (Original) The method of claim 5, wherein the beauty facility is at least one of a hair salon, a spa, or another establishment providing beauty services.

8. (Original) The method of claim 5, wherein the beauty products include at least one of moisturizer, anti-aging product, anti-wrinkle product, hair coloring, elasticity enhancing product, and cosmetic products.

9. (Original) The method of claim 5, wherein the at least one beauty products includes at least one service including hair styling, hair cutting, hair coloring, hair removal, skin treatment and make-up application.

10. (Original) The method of claim 5, wherein enabling electronic capture of at least one of the first and second first images includes providing the beauty facility with least one of software, an image capture device and directions for capturing images.

11. (Original) The method of claim 5, wherein enabling electronic capture of at least one of the first and second first images includes providing access, via a network, to image capture and management software.

12. (Original) The method of claim 5, wherein the external body condition is a skin condition of the subject's face.

13. (Original) The method of claim 5, wherein encouraging the subject to use at least one of the beauty products includes providing to the beauty facility directions for prescribing at least one of the beauty products.

14. (Original) The method of claim 13, wherein the directions are contained within software and wherein the software is configured to cause a prescription to be displayed to the subject on the display in the beauty facility.

15. (Original) The method of claim 5, further comprising enabling simultaneous display to the subject of the first and second images, and enabling the subject to identify differences between the first and second images.

16. (Original) The method of claim 5, wherein encouraging the subject to use at least one of the beauty products includes prescribing at least one beauty product to the subject as a function of detected differences between the first and second images.

17. (Original) The method of claim 12, wherein the differences are electronically ascertained using an image processing comparison between the first and second images.

18. (Original) The method of claim 12, wherein the subject is encouraged to auto-evaluate the first and second images to thereby detect differences.

19. (Original) The method of claim 5, wherein enabling electronic image capture includes providing a driver for an electronic image capture device.

20. (Original) The method of claim 15, wherein the electronic image capture device is at least one of a digital still camera, a digital video camera, a scanner, and a web cam.

21. (Original) The method of claim 5, implemented through cooperation between a beauty product distributor and at least one beauty facility, wherein the distributor encourages consumers to visit the at least one beauty facility, and enables the beauty facility to access software for capturing and recording at the beauty facility at least one of the first and second images.

22. (Original) The method of claim 5, implemented through cooperation between a beauty product distributor and at least one beauty facility, wherein the distributor enables the beauty facility to access software for capturing and recording at the beauty facility at least one of the first and second images, and wherein the distributor provides to the beauty facility at least one of the beauty products.

23. (Original) The method of claims 21 or 22, wherein the distributor is at least one of a manufacturer, reseller, and wholesaler of at least one of the beauty products.

24. (Original) The method of claim 23, wherein the distributor also provides to the beauty facility recordable media, chosen from at least one of magnetic storage media, optical disc media, flash memory devices, or other tangible media upon which computer readable information may be recorded, the recordable media for use in storing the first and second images and the information about use.

25. (Original) The method of claim 24, wherein the recordable media includes a visible marking identifying at least the distributor.

26. (Original) The method of claim 24 or 25, wherein the recordable media includes marking identifying the beauty facility.

27. (Original) The method of claim 5, further comprising enabling the subject to view the first and second images at locations remote from the beauty facility.

28. (Original) The method of claim 5, further comprising enabling the beauty facility to store the first image on recordable media, and encouraging the beauty facility to recommend to the subject that the subject capture and store the second image on the recordable media at a location remote from the beauty facility.

29. (Original) The method of claim 5, further comprising enabling the beauty facility to store the first image on recordable media, and encouraging the beauty facility to recommend to the subject that the subject return to the beauty facility for capture and storage of the second image on the recordable media.

30. (Original) The method of claim 5, conducted in a network environment, wherein at least some processing functions occur at a location remote from the beauty facility.

31. (Original) A method of recording beauty information, the method comprising:

- capturing, through a beauty facility, at least a first image of an external condition of a subject;
- establishing a subject record, the record including the first image;
- prescribing a cosmetic product to the subject for treating the external condition;
- capturing, through the beauty facility, at least a second image of the external condition of the subject, the second image being captured after the first image is captured;
- associating the at least one second image with the subject record; and
- providing the subject with viewing access to the subject record.

32. (Previously amended) A method of selling cosmetic products, the method comprising:

providing a beauty facility with technology for capturing external body condition images of a customer;

distributing at least one cosmetic product to the beauty facility;

instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product;

instructing the beauty facility to display to the customer the before and after images so that the customer may be provided with a visual indication of progress.

33. (Original) The method of claim 32, wherein instructing the beauty facility to capture images includes instructing the beauty facility on how to record images on a transportable medium.

34. (Original) The method of claim 32 or 33, further comprising providing the customer with software that enables the customer to view the images at a location remote from the beauty facility.

35. (Original) The method of claim 34, wherein providing the customer with software, includes providing the customer with access to a web site through which the images are viewable.

36. (Original) The method of claim 34, wherein providing the customer with software includes distributing the software to the customer through the beauty facility.

37. (Original) The method of claim 32, further comprising enabling the customer to capture images to the transportable medium at a location remote from the beauty facility.

38. (Original) The method of claim 37, further comprising enabling the customer to associate with each image a record of a beauty product used before each image is recorded.

39. (Previously presented) A beauty analysis method, comprising:
enabling a subject to record personal beauty information on a transportable medium;

enabling a plurality of beauty facilities to read the information on the transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities; and

enabling the personal information to be updated by the subject at a location remote from a beauty facility.

40. (Original) The method of claim 39, wherein the remote update is enabled, at least in part, by information exchanges initiated by the subject over an electronic network.

41. (Original) The method of claim 39, wherein the personal beauty information includes images of portions of the subjects' body.

42. (Original) The method of claim 39, wherein the transportable medium includes at least one of magnetic storage medium, optical disc, flash memory devices, or other tangible media upon which information may be recorded.

43. (Original) The method of claim 39, wherein the personal information stored on the transportable medium include time lapse images of portions of the subject's body, and wherein the subject is enabled to auto-evaluate visible changes over time, and to record the auto-evaluated visible changes on the transportable media

44. (Original) A beauty analysis method, comprising:
enabling a beauty facility to record on transportable medium personal beauty information about a subject;

enabling the subject to access, at a location remote from the beauty facility, the personal beauty information;

enabling the subject to update, at a location remote from the beauty facility, the personal beauty information; and

enabling the subject to compare, at a location remote from the beauty facility, the accessed personal beauty information and the updated personal beauty information.

45. (Original) A beauty tracking method, comprising:
- enabling an individual to record in a data structure information about the individual's cosmetic product usage;
 - enabling the individual to record in the data structure personal information, other than the cosmetic product usage information, the personal information including at least one of lifestyle information, information about physical characteristics of the individual, fashion preferences, area of residence, vacation patterns, and climate and weather conditions at areas of vacation and residence;
 - enabling an individual to update in the data structure cosmetic product usage information and personal information;
 - enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information; and
 - causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record.

46. (Original) A beauty advisory method, comprising:

enabling a subject to record in a data structure information about the subject's cosmetic product usage and about the subject's lifestyle;

comparing the recorded information with a database of information on cosmetic usage and lifestyles of a plurality of individuals;

determining whether the subject's cosmetic usage is consistent with the cosmetic usage and lifestyles of a trend of use by at least some of the plurality of individuals; and

causing, when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject.

47. (Original) The method of claim 46, further comprising enabling the subject to record personal information about the subject's physical characteristics, and wherein the caused at least one product recommendation is a function of the subject's lifestyle and physical information.

48. (Original) A beauty tracking method, comprising:

offering for sale beauty products;

facilitating electronic capture of a first image of an external body condition of a subject;

encouraging the subject to use at least one of the beauty products;

facilitating, after the subject has used the at least one cosmetic product, electronic capture of a second image of the external body condition of the subject, wherein capture of at least one of the first and second images occurs at a beauty facility;

facilitating capture and storage of information reflecting usage of at least one of the cosmetic products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image; and

enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured.

49. (Previously presented) A method for encouraging use of a beauty product, the method comprising:

- providing information about beauty products;
- providing instructions for storage of first information relating to an external body condition of a subject in a first time frame;
- providing instructions for storage of second information relating to an external body condition of a subject in a second time frame;
- analyzing the first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames; and
- prescribing at least one beauty product based on the extent of determined differences.

50. (Original) A method of recording beauty information, the method comprising:

- providing information about beauty care;
- providing instructions for storage of first information relating to an external body condition of a subject in a first time frame;
- providing instructions for storage of second information relating to an external body condition of a subject in a second time frame;
- providing instructions for storage of third information relating to behavior of a subject between the first and second time frames; and
- establishing a subject record, the record including the first, second and third information, wherein the subject is enabled to maintain control of the subject record.

51. (Original) The method of claim 50, wherein the subject is enabled to maintain control through the use of software that stores the record at a location with access controlled by the subject.

52. (Original) The method of claim 51, wherein the location is a portable information storage medium.

53. (Previously presented) The method of claim 1, further comprising presenting to the subject at least one depiction of data quantifying an effectiveness of the beauty product based on the first information, the second information, and at least part of the stored information.

54. (Previously presented) The method of claim 5, further comprising processing the first and second images of the external body condition of the subject to accentuate differences between the images.

55. (Previously presented) The method of claim 5, further comprising:
processing the first and second images of the external body condition of the subject to detect differences between said images; and
providing advice to a subject based on the detected differences and based on personal information associated with the subject.

56. (Previously presented) The method of claim 5, further comprising:
determining a probable cause of a difference between the first and second
images of the external body condition using personal information associated with the
subject; and
presenting to the subject the determined probable cause along with preventative
measures.

57. (Previously presented) The method of claim 32, wherein instructing
the beauty facility to capture images of the external body condition before and after
application of the at least one cosmetic product includes instructing the beauty facility to
capture and store information reflecting a nature of the application of the at least one
cosmetic product.

58. (Previously presented) The method of claim 39, wherein enabling a
subject to record personal beauty information on a transportable medium includes
enabling a subject to record, on the transportable medium, personal beauty information
relating to beauty habits of the subject.

59. (Previously presented) The method of claim 44, wherein enabling a
beauty facility to record on transportable medium personal beauty information about a
subject includes enabling a beauty facility to record on transportable medium personal
beauty information relating to beauty habits of the subject.

60. (Previously presented) The method of claim 49, wherein prescribing at least one beauty product comprises prescribing at least one beauty product based on the extent of determined differences and personal information associated with the subject.

61. (Previously presented) The method of claim 60, further comprising determining a probable cause of the differences using personal information associated with subject.

X. **Appendix B: Evidence Appendix to Appeal Brief Under Rule
41.37(c)(1)(ix)**

None.

XI. Appendix C: Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.